

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF : EXAMINER: JANVIER, D JEAN
MARTYN IAN BUTTERWORTH
SERIAL NO: 09/858,174
FILED: MAY 15, 2001 : GROUP ART UNIT 3688

**FOR: IMPROVEMENTS RELATED
TO TELECOMS**

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF UNDER 37 C.F.R. § 41.41

SIR:

Pursuant to 37 C.F.R. § 41.41, Appellant submits the following Reply Brief for consideration by the Board of Patent Appeals and Interferences ("Board") in reply to the Examiner's Answer dated September 16, 2010 ("Answer"), which is being submitted within two months from the date thereof pursuant to 37 C.F.R. § 41.41(a). Appellant respectfully requests consideration of the accompanying Appeal by the Board of Patent Appeals for allowance of the invention as presently recited in the Claims.

TABLE OF CONTENTS

- I. REAL PARTY-IN-INTEREST
- II. RELATED APPEALS AND INTERFERENCES
- III. STATUS OF CLAIMS
- IV. STATUS OF AMENDMENTS
- V. SUMMARY OF CLAIMED SUBJECT MATTER
- VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL
- VII. ARGUMENT
 - A. Rejection of Claims 1 and 4-8 under 35 U.S.C. § 102(b) by United States Patent No. 5,428,670 ("Gregorek") is improper because Gregorek fails to disclose the limitations presented
 - B. Rejection of Claims 18 and 21-25 under 35 U.S.C. § 102(b) by Gregorek is improper because Gregorek fails to disclose the limitations presented
 - C. Rejection of Claims 19-20 under 35 U.S.C. § 103(a) as being unpatentable over United States Patent No. 5,428,670 ("Gregorek") in view of U.S. Patent No. 6,205,432 ("Gabbard") is improper because not teaching exists in the cited art and the combination fails to disclose the limitations presented
- VIII. CONCLUSION
- IX. CLAIMS APPENDIX
- X. EVIDENCE APPENDIX
- XI. RELATED PROCEEDINGS APPENDIX

I. REAL PARTY-IN-INTEREST

The real party in interest is Host Telecom Limited, having an address at IPark House 200 Drake Street 713 Rochdale, Lancashire, United Kingdom OL16 1PJ, as evidenced by the Assignment recorded September 17, 2008 at reel/frame 021543/0001.

II. RELATED APPEALS AND INTERFERENCES

There are no related appeals or interferences.

III. STATUS OF CLAIMS

Claims 1,4-8 and 18-25 are pending and are attached in the Claims Appendix. Claims 23, 9-17 and 26-34 were previously cancelled without prejudice. Pending Claims 1,4-8 and 18-25 stand finally rejected by the Examiner. Appellant appeals the final rejection of Claims 1, 4-8 and 18-25.

IV. STATUS OF AMENDMENTS

No amendments were made subsequent to the final rejection mailed February 19, 2010.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The Claims are summarized as follows. In the summary below, the referenced portion of the Specification should be construed as only representative of the teachings that support the claimed feature(s). Thus, the cited portions are sufficient to support the claim, but are not necessarily the exclusive support in the Specification for such claim features.

Independent claim 1 is directed to a method for transmitting pre-recorded images using telecom networks, the method comprising the steps of detecting when a telecommunications apparatus 1 is used by a caller to send a message to a recipient. Page 7, lines 6-13; Fig. 1. The method also includes the steps of establishing a connection with a telecommunications apparatus 2 of the recipient and, thereafter, displaying a supplementary image at the telecommunications apparatus of the caller in addition to conventional connection messages. Page 1, lines 27-29, page 7, lines 11-13; page 8, lines 21-23; page 9, lines 24-32; Fig.1.

In addition, the method includes the step of, if the recipient does not answer during a predetermined time period, then replacing the supplementary image by connection message text. Page 2, lines 4-7. The method also includes the step of, if, during transmission of the supplementary image to the caller, a connection is established between the caller and the recipient, transmission of the supplementary image is terminated. Page 2, lines 9-13. Claims 4-8 depend from independent claim 1.

Independent claim 18 is directed to an apparatus for transmitting pre-recorded images using telecom networks, whereby when telecommunications apparatus is used by a caller 10 to send a message to a recipient 70, a supplementary image is visually transmitted from messaging equipment to the caller 10 in addition to, or to replace, conventional connection messages. Page 1, lines 27-29, page 7, lines 11-13; page 8, lines 21-23; page 9, lines 24-32; Fig.1. The apparatus comprises, means 20 for detecting a signal on a telecom system

indicating that there is an incoming message transmission. Page 7, lines 6-13; Fig.1.

The apparatus also includes means for establishing a connection with a telecommunications apparatus of the recipient 70 and means for responding to this detection and connection by conveying a supplementary image or images to the caller 10 in addition to, or to replace, conventional connection messages. Page 1, lines 27-29, page 7, lines 11-13; page 8, lines 21-23; page 9, lines 24-32; Fig.1. If the recipient 70 does not answer during a predetermined time period, then the means for responding to this detection and connection replacing the supplementary image by connection message text. Page 2, lines 4-7. If, during transmission of the supplementary image to the caller 10, a connection is established between the caller 10 and the recipient 70, then the means for responding to this detection and connection terminating transmission of the supplementary image is terminated. Page 2, lines 9-13. Claims 19-25 depend from independent claim 18.

The above is provided for illustration purposes and should not be construed as limiting in any way.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

The issues presented for consideration by the Board are as follows:

1. WHETHER CLAIMS 1 AND 4 – 8 ARE ANTICIPATED UNDER 35 U.S.C. § 102(B) BY UNITED STATES PATENT NO. 5,428,670 ("GREGOREK");
2. WHETHER CLAIMS 18 AND 21-25 ARE ANTICIPATED UNDER 35 U.S.C. § 102(B) BY UNITED STATES PATENT NO. 5,428,670 ("GREGOREK"); AND
3. WHETHER CLAIMS 19-20 ARE UNPATENTABLE UNDER 35 U.S.C. § 103(A) OVER GREGOREK IN VIEW OF UNITED STATES PATENT NO. 6,205,432 ("GABBARD")

ARGUMENTS

A. REJECTION OF CLAIMS 1 AND 4-8 UNDER 35 U.S.C. § 102(B) BY UNITED STATES PATENT NO. 5,428,670 ("GREGOREK") IS IMPROPER BECAUSE GREGOREK FAILS TO DISCLOSE THE LIMITATIONS PRESENTED

Appellant's position has been, and continues to be that Gregorek does not disclose the limitation that the announcement is replaced by conventional message text if the called party does not answer. Independent Claim 1 recites:

A method for transmitting pre-recorded images using telecom networks, the method comprising the steps of: detecting when a telecommunications apparatus is used by a caller to send a message to a recipient, establishing a connection with a telecommunications apparatus of the recipient, thereafter, displaying a supplementary image at the telecommunications apparatus of the caller in addition to, or to replace, conventional connection messages, if the recipient does not answer during a predetermined time period, then replacing the supplementary image by connection message text, and if, during transmission of the supplementary image to the caller, a connection is established between the caller and the recipient, transmission of the supplementary image is terminated.

Specifically, Appellant indicates in its Appeal Brief dated June 6, 2010 ("Appeal"):

Gregorek does not teach or suggest that, after establishing a connection with the second telephone 20, if the second telephone 20 is not answered during a predetermined time period, then replacing the announcement by connection message text. *See* Appeal, Page 11 ¶ 2.

In response to Appellant's argument, the Examiner Janvier, D Jean ("Examiner") noted in the Answer, that Gregorek discloses this limitation.

Specifically, the Examiner indicated the following:

[P]rior art is interpreted to meet the limitation "... if the recipient does not answer during a predetermined time period, then replacing the supplementary image by connection message text ... ", where prior art discloses "...A possible time frame for again trying to make the connection to the second telephone is every fifteen seconds. However, it is to be understood by those skilled in the art that any other suitable time frame, including a variable time frame, could be used in the alternative ..., Col. 5:35-65." See Answer Page 10 ¶ 2.

In reply, Appellant maintains that the subject matter in Col. 5:35-65 does **not** provide the support the Examiner has suggested. The passage the Examiner has suggested merely discloses repetitive behavior (based on a varying time frame) by the system in which to contact the second telephone. This passage does **not** disclose the ability to *replace* the supplementary image with connection message text. In fact, the passage forecloses the possibility of this specific limitation because this action prevents the calling party from hearing such connection message text because it is the system repeatedly trying to make a connection with the second telephone.

Specifically, Appellant points out in Gregorek:

If the second telephone is idle, the second switch 22 or the ANSS 23 can either activate the audible signal generator 14 to produce a conventional audible ringback signal or can activate the message generator 16 to play a series of prerecorded announcements to the calling party for a predetermined period of time. See Gregorek Column 5 Lines 35 – 40.

Gregorek discloses that either one or the other can be generated to the calling party. Gregorek provides further clarification of the above by indicating:

In either case, the resulting message or audible ringback signal indicates to the calling party that the second telephone 20 is not currently in use. If the second telephone 20 is busy, the second switch 22 or the ANSS 23 can either activate the audible signal generator 14 to generate a busy signal or activate the message

generator 16 to play a series of pre-recorded announcements to the calling party for a predetermined period of time while periodically checking to determine if the second telephone 20 is still busy. *See* Gregorek Column 5, Lines 43 – 53.

The disclosure in Gregorek is centered around the “Message Generator” 16. The Message Generator 16 determines which announcements are designated for the particular network address and plays the pre-recorded message in a predetermined segment of time until the telephone 20 is answered or until the call is abandoned. *See* Gregorek, Column 6, Lines 20 -25. This simply means the calling party hears a pre-recorded message until the called party answers, or the calling party hangs up the phone.

As discussed above and argued earlier by Appellant, there is no subject matter within Gregorek that supports the notion that connection message text *replaces* the announcement in the call stream if a call is not answered. While the Examiner has indicated that all limitations have been considered¹, this does not seem to be the case.

Moreover, the position presumably taken by the Examiner in the Answer (*not indicated as withdrawn*) is contrary to the Examiner’s position in the Final Office Action dated February 19, 2010, (“Final Office Action”) wherein the Examiner indicates:

Further, the claims recite “and if, during transmission of the supplementary image to the caller, a connection is established between the caller and the recipient, transmission of the supplementary image is terminated”. Here, it can be assumed that the transmission and/or display of the supplementary image to the caller

¹ Answer, Page 10 ¶ 2 (“The Examiner notes that for purposes of examination, prior art is interpreted to meet the limitation “... if the recipient does not answer during a predetermined time period, then replacing the supplementary image by connection message text”); *See also* Answer, Page 11 ¶1 (“The Examiner disagrees with the Appellant because, the Examiner is not ignoring any of the limitations from the instant Application”).

is completed during the "ring-back" or before a connection is established between the caller and the recipient. As noted above, the "if-then" claim limitation only addresses one side of the equation. In other words, the prior art has to disclose only one side of the equation, but not necessarily what is featured in the "if-then" claim limitation. See Final Office Action Page 2 ¶ 1.

Appellant maintains that addressing one side of the equation is improper. See *Ex Parte* Andrew Burdass, Appeal 2009-002029, June 16, 2009 ("We disagree with the Examiner's position and claim interpretation, and we find that the recited functionality in the "if . . . then . . ." statement must be taught by Birk and furthermore must be present in the claimed apparatus since the machine claim must have all of the recited functionalities whether they are used in every conceivable combination of operations or not").

Appellant submits that the Examiner is ignoring the clear language of the claim which requires both that "if the recipient does not answer during a predetermined time period, then replacing the supplementary image by connection message text" **and** that "if, during transmission of the supplementary image to the caller, a connection is established between the caller and the recipient, transmission of the supplementary image is terminated." See Appeal, Page 11 ¶ 3.

Accordingly, Appellant's invention is not anticipated, as a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros., Inc. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Here, Gregorek at least does not teach or suggest that if the recipient does not answer during a predetermined time period, then the supplementary image is replaced by connection message text.

For at least these independent reasons, Gregorek does not teach or suggest the subject matter defined by independent Claim 1. Accordingly, Appellant respectfully requests reversal of the rejection of Claim 1 as being anticipated by

Gregorek under 35 U.S.C. § 102(b). Because Claims 4 – 8 are dependent from independent Claim 1, those particular Claims are allowable for at least the same and other independent reasons.

B. REJECTION OF CLAIMS 18 AND 21-25 UNDER 35 U.S.C. § 102(B) BY GREGOREK IS IMPROPER BECAUSE GREGOREK FAILS TO DISCLOSE THE LIMITATIONS PRESENTED

As stated above, Appellant's position has been, and continues to be that Gregorek does not disclose the limitation that the announcement is replaced by conventional message text if the called party does not answer. Independent Claim 18 recites:

Apparatus for transmitting pre-recorded images using telecom networks, whereby when telecommunications apparatus is used by a caller to send a message to a recipient, a supplementary image is visually transmitted from messaging equipment to the caller in addition to, or to replace, conventional connection messages, wherein the apparatus comprises: means for detecting a signal on a telecom system indicating that there is an incoming message transmission; means for establishing a connection with a telecommunications apparatus of the recipient; and means for responding to this detection and connection by conveying a supplementary image or images to the caller in addition to, or to replace, conventional connection messages, if the recipient does not answer during a predetermined time period, then the means for responding to this detection and connection replacing the supplementary image by connection message text, and if, during transmission of the supplementary image to the caller, a connection is established between the caller and the recipient, then the means for responding to this detection and connection terminating transmission of the supplementary image.

Specifically, Appellant indicates in its Appeal:

Gregorek does not teach or suggest that, after establishing a connection with the second telephone 20, if the second telephone 20 is not answered during a predetermined time period, then replacing the announcement by connection message text. *See* Appeal, Page 11 ¶ 2.

In response to Appellant's argument, the Examiner noted in the Answer, that Gregorek discloses this limitation.

Specifically, the Examiner indicated the following:

[P]rior art is interpreted to meet the limitation "... if the recipient does not answer during a predetermined time period, then replacing the supplementary image by connection message text ... ", where prior art discloses "...A possible time frame for again trying to make the connection to the second telephone is every fifteen seconds. However, it is to be understood by those skilled in the art that any other suitable time frame, including a variable time frame, could be used in the alternative ...", Col. 5:35-65." *See* Answer Page 10 ¶ 2.

In reply, Appellant maintains that the subject matter in Col. 5:35-65 does **not** provide the support the Examiner has suggested. The passage the Examiner has suggested merely discloses repetitive behavior (based on a varying time frame) by the system in which to contact the second telephone. This passage does **not** disclose the ability to *replace* the supplementary image with connection message text. In fact, the passage forecloses the possibility of this specific limitation because this action prevents the calling party from hearing such connection message text because it is the system repeatedly trying to make a connection with the second telephone.

Specifically, Appellant points out in Gregorek:

If the second telephone is idle, the second switch 22 or the ANSS 23 can either activate the audible signal generator 14 to produce a conventional audible ringback signal or can activate the message generator 16 to play a series of prerecorded announcements to the calling party for a predetermined period of time. *See* Gregorek Column 5 Lines 35 – 40.

Gregorek discloses that either one or the other can be generated to the calling party. Gregorek provides further clarification of the above by indicating:

In either case, the resulting message or audible ringback signal indicates to the calling party that the second telephone 20 is not currently in use. If the second telephone 20 is busy, the second switch 22 or the ANSS 23 can either activate the audible signal generator 14 to generate a busy signal or activate the message generator 16 to play a series of pre-recorded announcements to the calling party for a predetermined period of time while periodically checking to determine if the second telephone 20 is still busy. *See* Gregorek Column 5, Lines 43 – 53.

The disclosure in Gregorek is centered around the “Message Generator” 16. The Message Generator 16 determines which announcements are designated for the particular network address and plays the pre-recorded message in a predetermined segment of time until the telephone 20 is answered or until the call is abandoned. *See* Gregorek, Column 6, Lines 20 -25. This simply means the calling party hears a pre-recorded message until the called party answers, or the calling party hangs up the phone.

As discussed above and argued earlier by Appellant, there is no subject matter within Gregorek that supports the notion that connection message text *replaces* the announcement in the call stream if a call is not answered. While the Examiner has indicated that all limitations have been considered², this does not seem to be the case.

² Answer, Page 10 ¶ 2 (“The Examiner notes that for purposes of examination, prior art is interpreted to meet the limitation “... if the recipient does not answer during a predetermined time period, then replacing the supplementary image by connection message text”); *See also* Answer, Page 11 ¶1 (“The Examiner disagrees with the Appellant because, the Examiner is not ignoring any of the limitations from the instant Application”).

Moreover, the position presumably taken by the Examiner in the Answer (*not indicated as withdrawn*) is contrary to the Examiner's position in the Final Office Action wherein the Examiner indicates:

Further, the claims recite "and if, during transmission of the supplementary image to the caller, a connection is established between the caller and the recipient, transmission of the supplementary image is terminated". Here, it can be assumed that the transmission and/or display of the supplementary image to the caller is completed during the "ring-back" or before a connection is established between the caller and the recipient. As noted above, the "if-then" claim limitation only addresses one side of the equation. In other words, the prior art has to disclose only one side of the equation, but not necessarily what is featured in the "if-then" claim limitation. See Final Office Action Page 2 ¶ 1.

Appellant maintains that addressing one side of the equation is improper. See *Ex Parte* Andrew Burdass, Appeal 2009-002029, June 16, 2009 ("We disagree with the Examiner's position and claim interpretation, and we find that the recited functionality in the "if . . . then . . ." statement must be taught by Birk and furthermore must be present in the claimed apparatus since the machine claim must have all of the recited functionalities whether they are used in every conceivable combination of operations or not").

Appellant submits that the Examiner is ignoring the clear language of the claim which requires both that "if the recipient does not answer during a predetermined time period, then replacing the supplementary image by connection message text" **and** that "if, during transmission of the supplementary image to the caller, a connection is established between the caller and the recipient, transmission of the supplementary image is terminated." See Appeal, Page 11 ¶ 3.

Accordingly, Appellant's invention is not anticipated, as a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros., Inc. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Here,

Gregorek at least does not teach or suggest that if the recipient does not answer during a predetermined time period, then the supplementary image is replaced by connection message text.

For at least these independent reasons, Gregorek does not teach or suggest the subject matter defined by independent Claim 18. Accordingly, Appellant respectfully requests reversal of the rejection of Claim 1 as being anticipated by Gregorek under 35 U.S.C. § 102(b). Because Claims 21 – 25 are dependent from independent Claim 18, those particular Claims are allowable for at least the same and other independent reasons.

C. REJECTION OF CLAIMS 19-20 UNDER 35 U.S.C. § 103(A) AS BEING UNPATENTABLE OVER UNITED STATES PATENT NO. 5,428,670 ("GREGOREK") IN VIEW OF U.S. PATENT NO. 6,205,432 ("GABBARD") IS IMPROPER BECAUSE NOT TEACHING EXISTS IN THE CITED ART AND THE COMBINATION FAILS TO DISCLOSE THE LIMITATIONS PRESENTED

As stated above, Appellant has shown that Gregorek does not teach or suggest the subject matter defined by independent Claim 18. Since an obviousness rejection requires a suggestion of all limitations in a claim, such a rejection cannot exist in this case because the Examiner has not made the requisite showing. *CFMT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003) (*citing In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). *See also* MPEP § 2143.03. Accordingly, because Claims 19-20 are dependent from independent Claim 18, those particular Claims are allowable for at least the same and other independent reasons, in that, Gregorek and United States Patent No. 6,205,432, ("Gabbard"), *without more*, cannot supply the limitations under 35 U.S.C. § 103(a).

Claim 19 includes the apparatus according to claim 18, wherein the apparatus is arranged to insert a supplementary image or images into the message and relay the message with inserted supplementary image(s) to a recipient. Further, Claim 20 is dependent on Claim 19 and includes wherein in the case of

text messaging the supplementary image(s) is/are inserted in a part of a message from the caller and will be visible to the recipient on retrieval of the text message.

Notwithstanding the above argument, Appellant disagrees that Gregorek and Gabbard render Appellant's Claims 19 – 20 obvious. In proceedings before the United States Patent and Trademark Office ("USPTO"), the Examiner bears the burden of establishing a *prima facie* case of obviousness based upon the prior art. *In re Fritch*, 972 F.2d 1260, 1265 (Fed. Cir.1992). Here, the Examiner has suggested that the combination of Gregorek and Gabbard discloses all the limitations of Claim 19 and Claim 20. *See Answer Page 17 ¶ 2*. Appellant respectfully disagrees and suggests that given the evidence provided by the Examiner, the preponderance of the evidence does **not** weigh in the favor of the Examiner's rejection under 35 U.S.C. § 103(a).

In *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 415 (2007), the Supreme Court emphasized "an expansive and flexible approach" to the obviousness question, but also reaffirmed the importance of determining "whether there was an apparent reason to combine the known elements *in the fashion claimed* by the patent at issue." *Id.* at 418. Ultimately, therefore, "[i]n determining whether obviousness is established by combining the teachings of the prior art, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art." *In re GPAC Inc.*, 57 F.3d 1573, 1581 (Fed. Cir. 1995). The Examiner has **not** provided that suggestion to those ordinarily skilled in the art, in that, the Examiner points to no teaching in Gregorek or Gabbard, suggesting that the combination be made.

In the Answer, the Examiner supplied the following:

Therefore, it would have been obvious to an ordinary skilled artisan, at the time of the invention, to incorporate the teachings of Gabbard into the system of Gregorek so as to send by a sender/caller a message, text message or e-mail message to a recipient, via a communication network or telecommunication system, wherein a

server is configured to insert a targeted advertisement (supplementary image) into the text message or e-mail message before the text message or e-mail message is delivered or played/displayed to the caller or recipient, thereby taking advantage of a text message or e-mail message sent, by a sender/caller, to a recipient to present to the recipient a targeted ad (supplementary image), based on the recipient's profile, inserted into the email message before it is delivered to the recipient, while enabling the owner of the communication or telecommunication system to raise important funds or revenue by charging the advertiser, associated with the inserted targeted advertisement, a fee for presenting or displaying/playing his advertisement to the recipient of the sender's/caller's text message or e-mail. See Answer, Pages 7 – 8¶ 2.

As such, the Examiner has not presented a sustainable basis for the obviousness rejection. MPEP § 2143 does provide some guidance. In that, MPEP § 2143 provides rationales that may support a conclusion of obviousness. Specifically, MPEP § 2143(G) indicates that some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention. However, Appellant understands that MPEP § 2143 is not an all-inclusive list, however, the MPEP requires that *some* rationale be provided in order to support a conclusion of obviousness. In this case, not only has the Final Office Action and the Answer failed to present one or more of the listed rationales in MPEP § 2143, the Final Office Action and Answer have failed to present **any** type of rationale.

Specifically, the Examiner indicates:

[S]o as to send by a sender/caller a message, text message or e-mail message to a recipient, via a communication network or telecommunication system, wherein a server is configured to insert a targeted advertisement (supplementary image) into the text message or e-mail message before the text message or e-mail message is delivered or played/displayed to the caller or recipient, thereby taking advantage of a text message or e-mail message sent.. See Answer, Page ¶1.

Here, the Examiner is plainly illustrating the advantages of Appellant's invention and not providing evidence of any teaching within the cited prior art. Appellant contends Examiner's rejection on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" being asserted. *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (quoted with approval in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007)).

The Examiner attempts to provide another line of reasoning in the Answer, but again, provides another conclusory statement illustrating the advantages of Appellant's invention, indicating:

[E]nabling the owner of the communication or telecommunication system to raise important funds or revenue by charging the advertiser, associated with the inserted targeted advertisement, a fee for presenting or displaying/playing his advertisement to the recipient of the sender's/caller's text message or e-mail...See Answer, Page 8 ¶1.

Again, the Examiner is not providing any teaching within the cited prior art. Appellant contends Examiner's rejection on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" being asserted. *In re Kahn* (quoted with approval in *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007)).

The Examiner has made a statement that it would have been obvious to an ordinary skilled artisan, at the time of the invention, to incorporate the teachings of Gabbard into the system of Gregorek. However, the Examiner has failed to provide any teachings or rationale to support this statement. Rather, the above statements are a draw on hindsight knowledge of Appellant's invention, wherein because the prior art does not contain or suggest the knowledge, the Examiner uses the invention as a template for the Examiner's own reconstruction, which is

an illogical and inappropriate process by which to determine patentability.”

Sensonics, Inc. v. Aerosonic Corp., 81 F.3d 1566, 1570 (Fed. Cir. 1996) (citing *W.L. Gore & Assoc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983)).

For at least these independent reasons, the Examiner has failed to present a *prima facie* case of obviousness as required by 35 U.S.C. §103. Accordingly, Appellant respectfully requests reversal of the rejection of Claims 19-20 as being obvious over Gregorek in view of Gabbard under 35 U.S.C. §103.

VIII. CONCLUSION

In view of the foregoing, Appellant respectfully requests that the Board reverse the rejections under 35 U.S.C. § 102(B) and 103 and pass the application to allowance. If consultation with Appellant's attorney will further prosecution, the undersigned is available for telephone consultation during normal business hours.

Respectfully submitted,

WASSERMAN, COMDEN, CASSELMAN, &
ESENSTEN L.L.P.

/Reid Dammann/

11/16/2010

Reid Dammann, Esq.

Customer No. 75398

5567 Reseda Boulevard, Suite 330

Tarzana, California 91356

818.705.6800

United States Patent and Trademark Office Reg. No. 57,227

IX. CLAIMS APPENDIX

1. A method for transmitting pre-recorded images using telecom networks, the method comprising the steps of: detecting when a telecommunications apparatus is used by a caller to send a message to a recipient, establishing a connection with a telecommunications apparatus of the recipient, thereafter, displaying a supplementary image at the telecommunications apparatus of the caller in addition to, or to replace, conventional connection messages, if the recipient does not answer during a predetermined time period, then replacing the supplementary image by connection message text, and if, during transmission of the supplementary image to the caller, a connection is established between the caller and the recipient, transmission of the supplementary image is terminated.
4. The method of claim 1, wherein a message to be transmitted to the recipient from the caller is a mixed media audio/video message and, wherein a supplementary image is presented for viewing to the caller prior to connection between caller and recipient being established or prior to transmission of the message from the caller.
5. The method of claim 1, wherein the image has at least one of an advertising content, an information content, or a combination thereof.
6. The method of claim 1, wherein a supplementary image is presented for viewing to the caller prior to connection between caller and recipient being established.
7. The method of claim 1, wherein supplementary images are conveyed only

to telecom system users who have indicated a willingness to receive such images.

8. The method of claim 1, wherein supplementary image insertion is available to all network service providers.

18. Apparatus for transmitting pre-recorded images using telecom networks, whereby when telecommunications apparatus is used by a caller to send a message to a recipient, a supplementary image is visually transmitted from messaging equipment to the caller in addition to, or to replace, conventional connection messages, wherein the apparatus comprises: means for detecting a signal on a telecom system indicating that there is an incoming message transmission; means for establishing a connection with a telecommunications apparatus of the recipient; and means for responding to this detection and connection by conveying a supplementary image or images to the caller in addition to, or to replace, conventional connection messages, if the recipient does not answer during a predetermined time period, then the means for responding to this detection and connection replacing the supplementary image by connection message text, and if, during transmission of the supplementary image to the caller, a connection is established between the caller and the recipient, then the means for responding to this detection and connection terminating transmission of the supplementary image.

19. The apparatus according to claim 18, wherein the apparatus is arranged to insert a supplementary image or images into the message and relay the message with inserted supplementary image(s) to a recipient.

20. The apparatus of claim 19, wherein in the case of text messaging the supplementary image(s) is/are inserted in a part of a message from the caller and will be visible to the recipient on retrieval of the text message.
21. The apparatus of claim 18, wherein a message to be transmitted to the recipient from the caller is a mixed media audio/video message and, wherein a supplementary image is presented for viewing to the caller prior to connection between caller and recipient being established or prior to transmission of the message from the caller.
22. The apparatus of claim 18, wherein the apparatus comprises cellular/wired telecommunications systems and other terrestrial or satellite transmissions, or email transmission systems capable of receiving text messaging.
23. The apparatus of claim 22, wherein the telecommunications system is configured so as to convey such supplementary images only to system users who have indicated a willingness to receive such images.
24. The apparatus of claim 18, wherein the supplementary image also has an audible message associated with it and transmitted to the caller during a predetermined time period.
25. The apparatus of claim 24, wherein the predetermined time period is selected by an advertising organization.

X. EVIDENCE APPENDIX

No evidence is submitted in this Appeal.

XI. RELATED PROCEEDINGS APPENDIX

None.